



1636

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# TRANSMITTAL FORM

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Application Number	10/005,983
Filing Date	November 7, 2001
First Named Inventor	Keith D. Allen
Group Art Unit	1636
Examiner Name	Celine X. Qian
Attorney Docket Number	R-517

Total Number of Pages in This Submission

## ENCLOSURES (check all that apply)

- ☐ Fee Transmittal Form
- ☐ Fee Attached
- ☒ Amendment / Reply - Restriction Requirement
- ☐ After Final
- ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
- ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53

- ☐ Assignment Papers (for an Application)
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) \_\_\_\_\_

- ☐ After Allowance Communication to Group
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☐ Other Enclosure(s) (please identify below):

Remarks

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## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Kelly L. Quast, Reg. No. 52,141
Signature	<i>Kelly L. Quast</i>
Date	March 10, 2003

## CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: 3-10-03

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March 10, 2003

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#9

Applicant: **Keith D. ALLEN *et al.***

Serial No.: **10/005,983**

Filed: **November 7, 2001**

Title: **Transgenic Mice Containing PERK  
Protein Kinase Gene Disruptions**

Group Art Unit: **1636**

Examiner: **Qian, Celine X.**

Customer No. **26619**

Docket/Order No. **R-517**

Date: **March 10, 2003**

**RESPONSE TO RESTRICTION REQUIREMENT**

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Sir:

In response to the Office Action mailed February 11, 2003, concerning the Examiner's restrictions, Applicants hereby provisionally elect, with traverse, Invention I (claims 1-10, 12 and 14-22), drawn to a PERK targeting vector, a method of making said vector, a PERK gene knockout animal, cells isolated from said animal, and a method of making said animal.

In the restriction, the Examiner asserts that claims 1-24 are drawn to six distinct subjects, grouped as: Invention I (claims 1-10, 12 and 14-22), drawn to a PERK targeting vector, a method of making said vector, a PERK gene knockout animal, cells isolated from said animal, and a method of making said animal; Invention II (claim 11), drawn to a method of identifying an agent that regulates PERK expression by using a PERK knockout cell; Invention III (claim 11), drawn to a method of identifying an agent that regulates PERK function by using a PERK knockout cell; Invention IV (claim 13), drawn to an agent that regulates the expression or function of PERK; Invention V (claim 23), drawn to an agent that ameliorates a phenotype of the PERK knockout mouse; and Invention VI (claims 24 and 25), drawn to an agonist or an antagonist of PERK. Applicants respectfully traverse the requirement for restriction and request reconsideration and withdrawal of the requirement.

As stated in MPEP §803, the requirements for a proper claim restriction are as follows: "(a) the inventions must be independent or distinct as claimed; and (b) there must be a serious burden on the examiner if restriction is required."

A proper claim restriction must place a “serious burden” on the Examiner if the claims were examined without a restriction. In order to establish a serious burden, the Examiner must “show by appropriate explanation one of the following: separate classification thereof, a separate status in the art, or a different field of search.” This showing of a serious burden is required even if the claimed inventions have been shown to be distinct. See MPEP §808.02

The instant Office Action generally asserts that restriction is warranted between Inventions I through VI in that the claimed inventions are patentably distinct. The Examiner has based this conclusion on alleged material (biological, chemical or functional) differences between compositions, or alleged differences in the materials and modes of operation required for methods. However, Applicants submit that the Examiner has not established that a serious burden would result from a search of the invention groups together. Applicants do not believe that the Examiner has fulfilled the requirements for a proper claim restriction based on a serious burden standard. Applicants believe that a search of any one of Invention groups I through VI would produce results that would encompass the subject matter of each of the invention groups. Thus, a serious burden would not be placed on the Examiner in order to conduct a search and examination of the claims of Inventions I through VI.

Specifically, the Examiner asserts that the claims of Invention I and Inventions IV-VI are patentably distinct in that the inventions are drawn to materially distinct compositions and methods that are not related. In particular, the Examiner asserts that the compositions of Invention I and Inventions IV-VI are biologically, chemically and functionally distinct from each other. Applicants disagree with the Examiner’s conclusion in that the subject matter of Invention I and Inventions IV-VI are closely related. Thus, the additional burden of a separate search or examination would not be required.

The Examiner also asserts that the claims of Invention II and Invention III are patentably distinct in that the inventions are drawn to methods that require different starting materials and modes of operation. Applicants disagree with the Examiner’s conclusion in that the inventions are related. In particular, the inventions relate to methods of using a PERK disrupted cell to identify agents that modulate PERK. The methods require the same or closely related steps and modes of operation. Applicants submit that a reasonable search or examination of the prior art on this subject would produce results encompassing the subject matter of both invention groups, and would not put serious burden on the Examiner.

Finally, the Examiner asserts that the claims of Inventions I, and IV-VI and Inventions II and III are patentably distinct because the inventions are unrelated, and have different modes of operation, different functions, or different effects. Applicants disagree with the Examiner's conclusion. Applicants believe that a reasonable search of the prior art, *e.g.* a search based on PERK disruptions, would produce results related to each of the invention groups. A search and examination of the claims of each of these inventions can therefore be made without additional burden on the Examiner.

Although Applicants have provisionally elected Invention I for the purposes of advancing prosecution of the present application, Applicants contend for the foregoing reasons that the requirement for restriction between Inventions I through VI is improper. Accordingly, Applicants respectfully request reconsideration and withdrawal of the requirement.

Respectfully submitted,

Date: 3/10/03

Kelly L. Quast  
Kelly L. Quast (Reg. No. 52,141)

Deltagen, Inc.  
740 Bay Road  
Redwood City, CA 94063  
(650) 569-5100

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I hereby certify that this correspondence and its listed enclosures is being deposited with the United States Postal Service as First Class Mail, postage paid, in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231 on **March 10, 2003**

Name: **Deborah A. Mojarro**

Signed: Deborah A. Mojarro

Date: 3/10/03